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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,329	02/13/2001	Koji Fukumoto	826.1675/JDH	9064
21171 7590 08/01/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER NASH, LASHANYA RENEE	
			ART UNIT 2153	PAPER NUMBER
			MAIL DATE 08/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/781,329	Applicant(s) FUKUMOTO ET AL.	
	Examiner LaShanya R. Nash	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to an Amendment filed 15 May 2007. Claims 1,2, and 4-9 are presented for further consideration. Claim 3 is cancelled.

Response to Arguments

Applicant's arguments filed 15 May 2007 have been fully considered but they are not persuasive.

In considering the Applicant's arguments the following factual remarks are noted:

(I) Applicant contends that Gilbert and Shaughnessy individually or in combination do not teach "the keyword information is designated by the sender and different for respective receivers".

In considering (I), Applicant contends that Gilbert and Shaughnessy individually or in combination do not teach "the keyword information is designated by the sender and different for respective receivers". Examiner respectfully disagrees. Examiner asserts that Gilbert explicitly teaches the e-mail emphasizing method and system wherein the sender (i.e. originating user) designates information, that is different for each of the respective receivers, in order to subsequently emphasize that information for the aforementioned designated recipient in an e-mail transmission (column 4, lines 59-61; column 5, lines 6-16). Specifically, Gilbert discloses a sender (i.e. originating user) that designates different portions of a broadcast e-mail message to be

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emphasized differently associated with the receiving user, as a specific portion of an e-mail (i.e. "finish testing the new prototypes"; Figure 5-item 120) is in italics only for a recipient "John" (column 8, lines 19-31) and another portion of the e-mail message (i.e. "complete sales plan by Thursday"; Figure 5-item 130) is bold only for the recipient "Fred" (column 8, lines 32-37). Therefore, Gilbert expressly teaches a sending user designating different actions that is to be applied for different e-mail portions for each of the respective receivers.

Examiner further asserts that Shaughnessy discloses an e-mail modification method and system wherein designated keyword information is different for respective receivers. Shaughnessy discloses that portions of an e-mail message destined for a particular receiving user are modified on the basis of different predefined action rules associated with each of the varying users. Examiner asserts that the action rules are independently determined and different for each user (i.e. rules are determined by a table look-up for intended recipient of the message; column 4, line 66-column 5, line 6; column 5, line 17-29). Furthermore, these aforementioned action rules are inclusive of certain keywords, where portions of the e-mail are selected for modification for a particular user based on the keywords that are both designated by that user's action rules and are identified in the e-mail message to be transmitted to the user (column 6, line 30-39; column 5, lines 40-55; Figure 3-item 350). Therefore, it logically follows that independent and dissimilar action rules, containing particular keywords, that are designated for different users respectively evidences that Shaughnessy suggests inherently, if not at least implicitly, that the keyword information is accordingly different

for respective receivers. Therefore, Examiner asserts that the combination of Gilbert and Shaughnessy teaches keyword information designated by the sender and different for respective receivers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (US Patent 6,529,942) and further in view of Shaughnessy et al. (US Patent 5,928,325).

Gilbert teaches an email system and method which allows the originating user to customize text for a specific recipient in a multiple recipient email system (i.e. broadcast), (abstract).

In reference to claim 1, Gilbert shows that the E-mail system with recipient-specific content system includes:

- A receiving device (i.e. receiver; Figure 1-receiver) receiving transmission information transmitted from a sender (Figure 1-sender) to a plurality of receivers, (column 3, line 24 to column 4, line 30) and

- An emphasizing device (i.e. network computer of sender) emphasizing and highlighting (i.e. size, color, bold, italic, etc.; column 4, lines 54-67);
- A storing device (i.e. memory; column 3, lines 34-41) storing information predetermined for respective receivers (i.e. identifier codes; column 6, lines 10-31; column 7, lines 8-24), wherein the information is designated by the sender and different for respective receivers (e.g. John is identified with "a" and Fred identified with "b"; column 8, lines 1- 43; Figure 5);
- Different parts the transmission information for respective receivers (i.e. select users to receive modified email message; column 5, lines 5-26), and preparing E-mail information (i.e. embedding text format commands and identifier codes; column 8, lines 1-18) including all of the transmission information with the transmission information in which the different parts are for respective receiver (columns 5-7; Figure 5),
- A transmitting device transmitting the E-mail information including all of the transmission information to respective receivers (i.e. receiver sensitive formatting; Figure 6- Emails for John, Harry, Mary and Original Email), (column 8, line 44 to column 9, line 18).

Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach a storing device storing, independent of receiving the transmission information, keyword information predetermined for each receiver and subsequently highlighting these keywords included in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert as evidenced by Shaughnessy.

In an analogous art, Shaughnessy discloses a system for modifying E-mail messages for respective recipients over the Internet (abstract). Shaughnessy further shows a storing device (i.e. rules memory; Figure 1-item 25) storing, independent of receiving the transmission information (i.e. predetermined action rules stored in rules memory by a system designer; column 5, lines 30-41; column 6, lines 30-35), keyword information predetermined for respective receivers, wherein the keyword information is highlighting in E-mails for the receiver (i.e. based on identified recipient, the message is modified to select message portions containing keywords; column 4, line 66-column 5, line 6; column 5, lines 42-55). Given this feature a person of ordinary skill in the art at the time of the invention would have readily recognized the advantages of modifying the recipient-specific E-mail system disclosed by Gilbert in order to dynamically examine and efficiently modify email content based on keywords intended for recipients having multiple devices, thereby increasing ease of use (Shaughnessy; column 3, lines 20-47).

In reference to claim 2, Gilbert shows receiving device that receives a part of the transmission information that the sender designates and information about a corresponding transmission destination and emphasizing device that emphasizes and highlights the designated part and prepares E-mail information for a receiver corresponding to the transmission destination, (columns 5-6).

In reference to claim 4, Gilbert shows a terminal apparatus (Figure 1-sender) comprising:

- Transmitting device transmitting transmission information prepared for a plurality of receivers (i.e. via network connection; column 3, lines 58 to column 4, line 16) including all of the transmission information and information predetermined for respective receivers (i.e. identifier codes; column 6, lines 10-31; column 7, lines 8-24), wherein the information is designated by the sender and different for respective receivers (e.g. John is identified with "a" and Fred identified with "b"; column 8, lines 1- 43; Figure 5); and
- An indication device (i.e. software program executing on networked computer of sender; column 4, line 30 to column 5, line 5) indicating E-mail information that emphasizes and highlights different parts of the transmission information for respective receivers; preparing E-mail information for respective receivers including all of the transmission information (columns 6-7); and
- Transmitting the E-mail information for respective receivers, with all of the transmission information sent to all respective receivers (i.e. receiver sensitive formatting; Figure 6- Emails for John, Harry, Mary and Original Email), (column 5; columns 8-9).

Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach a storing device storing, independent of receiving the transmission information, keyword information predetermined for each receiver and subsequently highlighting

these keywords included in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert, as evidenced by Shaughnessy.

In an analogous art, Shaughnessy discloses a system for modifying E-mail messages for respective recipients over the Internet (abstract). Shaughnessy further shows a storing device (i.e. rules memory; Figure 1-item 25) storing, independent of receiving the transmission information (i.e. predetermined action rules stored in rules memory by a system designer; column 5, lines 30-41; column 6, lines 30-35), keyword information predetermined for respective receivers, wherein the keyword information is highlighting in E-mails for the receiver (i.e. based on identified recipient, the message is modified to select message portions containing keywords; column 4, line 66-column 5, line 6; column 5, lines 42-55). Given this feature a person of ordinary skill in the art at the time of the invention would have readily recognized the advantages of modifying the recipient-specific E-mail system disclosed by Gilbert, in order to dynamically examine and efficiently modify email content based on keywords intended for recipients having multiple devices, thereby increasing ease of use (Shaughnessy; column 3, lines 20-47).

In reference to claim 5, Gilbert discloses developed software program including instructions to carry out the recipient specific email methods on computing systems (column 4, lines 16-67). As applied to previous claims, functions of the electronic mail system, as shown by Gilbert, include: receiving transmission information from a sender to a plurality of receivers; emphasizing and highlighting the different parts of transmission information for each receiver; preparing E-mail information for respective

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receivers; and transmitting the E-mail information for respective receivers. Therefore, Gilbert teaches a system comprising executable code that specifically implements the previously stated functions. This is equivalent to the software program disclosed by the applicant.

Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach information independent of receiving the transmission information, predetermined for respective receivers and subsequently emphasizing this information in E-mails. Nonetheless this feature would have been an obvious modification to the method disclosed by Gilbert as evidenced by Shaughnessy.

In an analogous art, Shaughnessy discloses a method for modifying E-mail messages for respective recipients over the Internet (abstract). Shaughnessy further shows a storing device (i.e. rules memory; Figure 1-item 25) storing, independent of receiving the transmission information (i.e. predetermined action rules stored in rules memory by a system designer; column 5, lines 30-41; column 6, lines 30-35), keyword information predetermined for respective receivers, wherein the keyword information is highlighting in E-mails for the receiver (i.e. based on identified recipient, the message is modified to select message portions containing keywords; column 4, line 66-column 5, line 6; column 5, lines 42-55). Given this feature a person of ordinary skill in the art at the time of the invention would have readily recognized the advantages of modifying the recipient-specific E-mail method disclosed by Gilbert, in order to dynamically examine and efficiently modify email content based on keywords intended for recipients having multiple devices, thereby increasing ease of use (Shaughnessy; column 3, lines 20-47).

In reference to claim 6, Gilbert shows a method (Figures 2&4; columns 4-7) comprising:

- Preparing transmission information to be transmitted from a sender to a plurality of receivers (Figure 2-item 60); and
- Emphasizing and highlighting the transmission information for respective receivers (Figure 2-items 64-68);
- Preparing E-mail information for respective receivers, (Figure 2-item 72);
- Transmitting the E-mail information including all of the transmission information to all respective receivers, (Figure 2-item 73);
- Emphasizing and displaying the transmission information for respective receivers, (Figure 2-item 76; Figure 4a; Figure 6; column 8).

Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach information independent of receiving the transmission information, predetermined for respective receivers and subsequently emphasizing this information in E-mails. Nonetheless this feature would have been an obvious modification to the method disclosed by Gilbert as evidenced by Shaughnessy.

In an analogous art, Shaughnessy discloses a method for modifying E-mail messages for respective recipients over the Internet (abstract). Shaughnessy further shows a storing device (i.e. rules memory; Figure 1-item 25) storing, independent of receiving the transmission information (i.e. predetermined action rules stored in rules memory by a system designer; column 5, lines 30-41; column 6, lines 30-35), keyword

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information predetermined for respective receivers, wherein the keyword information is highlighting in E-mails for the receiver (i.e. based on identified recipient, the message is modified to select message portions containing keywords; column 4, line 66-column 5, line 6; column 5, lines 42-55). Given this feature a person of ordinary skill in the art at the time of the invention would have readily recognized the advantages of modifying the recipient-specific E-mail method disclosed by Gilbert, in order to dynamically examine and efficiently modify email content based on keywords intended for recipients having multiple devices, thereby increasing ease of use (Shaughnessy; column 3, lines 20-47).

In reference to claim 7, Gilbert explicitly discloses an E-mail system (Figure 1), comprising:

- Receiving means (Figure 1-receiver) for receiving transmission information transmitted from a sender (Figure 1-sender) to a plurality of receivers, transmitting means for transmitting the E-mail information for each receiver (column 3, line 24 to column 4, line 30); and
- Emphasizing means (i.e. network computer of sender) for emphasizing and highlighting (i.e. size, color, bold, italic, etc.; column 4, lines 54-67) the transmission information for respective receivers (i.e. select users to receive modified email message; column 5, lines 5-26), and preparing the email (i.e. embedding text format commands) for respective receiver (columns 5-7),

- Transmitting the E-mail information including all of the transmission information to all respective receivers (i.e. receiver sensitive formatting; Figure 6- Emails for John, Harry, Mary and Original Email), (column 5; columns 8-9).

Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach information independent of receiving the transmission information, predetermined for respective receivers and subsequently emphasizing this information in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert as evidenced by Shaughnessy.

In an analogous art, Shaughnessy discloses a system for modifying E-mail messages for respective recipients over the Internet (abstract). Shaughnessy further shows a storing device (i.e. rules memory; Figure 1-item 25) storing, independent of receiving the transmission information (i.e. predetermined action rules stored in rules memory by a system designer; column 5, lines 30-41; column 6, lines 30-35), keyword information predetermined for respective receivers, wherein the keyword information is highlighting in E-mails for the receiver (i.e. based on identified recipient, the message is modified to select message portions containing keywords; column 4, line 66-column 5, line 6; column 5, lines 42-55). Given this feature a person of ordinary skill in the art at the time of the invention would have readily recognized the advantages of modifying the recipient-specific E-mail system disclosed by Gilbert, in order to dynamically examine and efficiently modify email content based on keywords intended for recipients having multiple devices, thereby increasing ease of use (Shaughnessy; column 3, lines 20-47).

In reference to claim 8, Gilbert discloses the E-mail system with recipient-specific content system includes:

- A system (Figure 1) for propagating a signal from a propagating computer (i.e. Figure 1-sender) to receiver computers (i.e. Figure 1-receiver), (i.e. via network; Figure 1-item 10) the propagating computer of the system comprising a program (i.e. software program; column 4, lines 30-67),

As applied to previous claims, functions of the electronic mail system, as shown by Gilbert, include: receiving transmission information from a sender to a plurality of receivers; emphasizing and highlighting the different parts of transmission information for each receiver; preparing E-mail information for respective receivers; and transmitting the E-mail information including all of the transmission information to respective receivers.

Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach information independent of receiving the transmission information, predetermined for respective receivers and subsequently emphasizing this information in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert as evidenced by Shaughnessy.

In an analogous art, Shaughnessy discloses a system for modifying E-mail messages for respective recipients over the Internet (abstract). Shaughnessy further shows a storing device (i.e. rules memory; Figure 1-item 25) storing, independent of receiving the transmission information (i.e. predetermined action rules stored in rules

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memory by a system designer; column 5, lines 30-41; column 6, lines 30-35), keyword information predetermined for respective receivers, wherein the keyword information is highlighting in E-mails for the receiver (i.e. based on identified recipient, the message is modified to select message portions containing keywords; column 4, line 66-column 5, line 6; column 5, lines 42-55). Given this feature a person of ordinary skill in the art at the time of the invention would have readily recognized the advantages of modifying the recipient-specific E-mail system disclosed by Gilbert, in order to dynamically examine and efficiently modify email content based on keywords intended for recipients having multiple devices, thereby increasing ease of use (Shaughnessy; column 3, lines 20-47).

In reference to claim 9, Gilbert explicitly discloses a method (Figures 2&4; columns 4-7) for recipient-specific content emailing. Gilbert discloses the method to comprise:

- Receiving information for different destinations with the information having different parts (Figure 2-items 60-64);
- Emphasizing the different parts responsive to the destinations (Figure 2-item 68-72; Figure 3);
- Sending all of the information by email to all the destinations with each destination receiving all of the information, to with at least one of the parts emphasized responsive to the destination (Figure 2-item 73); and
- Displaying the information with one of the parts emphasized at least one of the destinations, (Figure 2-item 76; Figure 4a; Figure 6; column 8).

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Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach information independent of receiving the transmission information, predetermined for respective receivers and subsequently emphasizing this information in E-mails. Nonetheless this feature would have been an obvious modification to the method disclosed by Gilbert as evidenced by Shaughnessy.

In an analogous art, Shaughnessy discloses a method for modifying E-mail messages for respective recipients over the Internet (abstract). Shaughnessy further shows a storing device (i.e. rules memory; Figure 1-item 25) storing, independent of receiving the transmission information (i.e. predetermined action rules stored in rules memory by a system designer; column 5, lines 30-41; column 6, lines 30-35), keyword information predetermined for respective receivers, wherein the keyword information is highlighting in E-mails for the receiver (i.e. based on identified recipient, the message is modified to select message portions containing keywords; column 4, line 66-column 5, line 6; column 5, lines 42-55). Given this feature a person of ordinary skill in the art at the time of the invention would have readily recognized the advantages of modifying the recipient-specific E-mail method disclosed by Gilbert, in order to dynamically examine and efficiently modify email content based on keywords intended for recipients having multiple devices, thereby increasing ease of use (Shaughnessy; column 3, lines 20-47).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

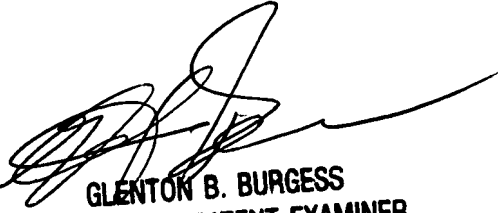
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya R Nash whose telephone number is (571) 272-3957. The examiner can normally be reached on M-F 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LaShanya Nash *LN*
Art Unit, 2153
July 24, 2007


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